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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,140	01/08/2007	Philip Wilson Howard	065435-9083-US00	4288

23510 7590 12/06/2010
MICHAEL BEST & FRIEDRICH LLP
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Milwaukee, WI 53202

EXAMINER

RODRIGUEZ-GARCIA, VALERIE

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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12/06/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,140	Applicant(s) HOWARD ET AL.	
	Examiner VALERIE RODRIGUEZ-GARCIA	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,10-21,23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 10-21 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6,8 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

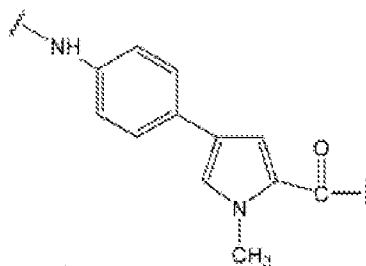
- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/03/2010 and 08/27/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/14/2010 has been entered.

Applicants previously elected as polyamido moiety of formula (II) the fragment



derived from compound 32 (p. 59) , in the reply filed on 04/29/2009. In view of applicant's election and of the definition of "moiety" (discussed in page 6 of office action of 07/06/2009), the claims are examined as drawn to a polyamido fragment and not to a polyamido per se. The elected species was not allowable for the reasons of record.

Claims 7, 9, 22, 24 and 26 were canceled. Claims 1-6, 8, 10-21, 23 and 25 are pending.

Claims 1-5, 10-21 and 25 are withdrawn as been directed to non-elected inventions.

Claims 6, 8 and 23 are the subject of this action

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

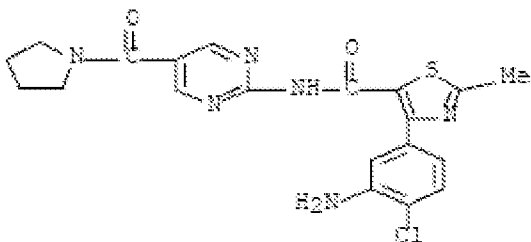
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

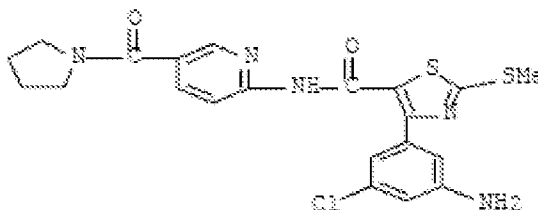
2. Claims 6, 8 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 1998/28282 (now US 6,187,797).

The prior art teaches many compounds which read on the rejected claims (see whole document). For example, see compounds

RN 1109548-61-9 HCAPLUS
CN 5-Thiazolacarbamide, 4-(3-ami
pyrrolidinylcarbonyl)-2-pyrimid

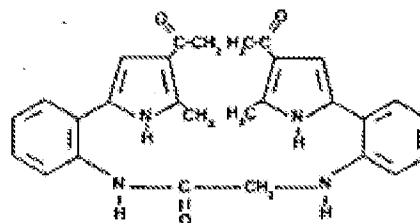


RN 1109549-39-4 HCAPLUS
CN INDEX NAME NOT YET ASSIGNED



found in the tables of the document starting on page 159. See also the compounds Examples 13 or 23 of page 163. The compounds are administered with diluents, excipients or carriers (page 218).

3. Claims 6, 8 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Dattolo *et al.* (J. Heterocyclic Chem., 17, 701 (1980)).



The prior art teaches the following compound in ethanol (Scheme in page 701 and page 702, second column, second paragraph).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8 it is unclear what is intended by reciting “heteroarylene groups derived from C5 heteroaryl groups”. The meaning of “derived from” is “formed from” or “developed from”. One can form a heteroarylene from a C5 heteroaryl by adding a C1, thus, the heteroarylene will be a C6. The claim seems to be reciting the source where the heteroarylene comes from. However, this does not limit the heteroarylene.

Claim 8 does not further limit the subject matter of claim 6 because A and B are heteroarylene (as in any heteroarylene). However, in claim 6 A and B are C₅₋₆ heteroarylene.

Conclusion

The claims are not in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE RODRIGUEZ-GARCIA whose telephone number is (571)270-5865. The examiner can normally be reached on Monday-Friday, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VALERIE RODRIGUEZ-GARCIA/
Examiner, Art Unit 1626

/YONG CHU/
Primary Examiner, Art Unit 1626